

I. Statement of the Facts

The face of U.S. Patent No. 7,011,498 ("the '498 patent") indicates a patent term adjustment of 417 days. Applicants calculate that the patent term adjustment for the '498 patent should be 488 days, as indicated on the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) ("Determination") mailed October 4, 2005 (copy attached). The USPTO erroneously reduced the patent term adjustment indicated on the Determination by 71 days due to Applicants' filing of a Statement Concerning Small Entity Status, which was filed along with the Issue Fee Transmittal and Issue Fee payment on January 3, 2006. Such a reduction is in contrary to USPTO procedures and rules. In light of the circumstances explained in more detail below, Applicants respectfully request reconsideration of the USPTO's improper 71-day reduction in Applicants' patent term adjustment.

For the USPTO's convenience, Applicants have attached a copy of the USPTO's Patent Term Adjustment History retrieved from the USPTO's public PAIR page.

A. Relevant Dates

The relevant actions during prosecution of the application are as follows:

Date	Action	PTA Basis under 37 C.F.R.	Adjustment
01-22-02	Applicants file App. No. 10/051,304.	n/a	0
10-21-04	USPTO mails Restriction Requirement.	§ 1.702(a)(1)	+579 days
11-22-04	Applicants file Response.	none	0
02-03-05	USPTO mails Non-Final Rejection.	none	0
08-02-05	Applicants file Response.	§ 1.704(b)	-91 days
10-04-05	USPTO mails Notice of Allowance.	none	0

Date	Action	PTA Basis under 37 C.F.R.	Adjustment
01-03-06	Applicants file Issue Fee Transmittal, Issue Fee payment, and Statement Concerning Small Entity Status.	none	0
NET PTA	Proper PTA calculation		+488 days

B. Correct Patent Term Adjustment

As is indicated in the table above, Applicants are entitled to 488 days of patent term adjustment because the USPTO failed to comply with 37 CFR § 1.702(a)(1) when the USPTO mailed its first substantive communication to Applicants 579 days after the 14-month time period provided for the USPTO to issue a first substantive Office Action following the filing date of a non-provisional application. 37 C.F.R. § 1.702(a)(1). In particular, Applicants filed the application, which issued as the '498 patent, on January 22, 2002. The USPTO mailed a Restriction Requirement on October 21, 2004, which is 579 days beyond the 14-month time period permitted under USPTO rules. Id. Applicants filed a response to the Office Action dated February 3, 2005, on August 2, 2005, which is 91 days after the three-month time period to file a reply to the Office Action. See § 1.704(b). Accordingly, Applicants are entitled to 488 days of patent term adjustment, which represents the difference between the USPTO's examination delay of 579 days and the 91-extra days associated with responding to the Office Action mailed February 3, 2005.

On October 4, 2005, the USPTO issued the Determination, which indicates that Applicants are entitled to a patent term adjustment of 488 days. The face of the

'498 patent, however, indicates that a patent term adjustment of 417 days rather than the proper 488-day patent term adjustment.

The Patent Term Adjustment History on the USPTO's PAIR page indicates the patent term adjustment has been reduced by 71 days due to Applicants' alleged January 3, 2006, filing of a document characterized as "Miscellaneous Incoming Letter." Applicants have enclosed a copy of the so-called "Miscellaneous Incoming Letter," which has been printed from the USPTO's "Image File Wrapper" page corresponding to the '498 patent. According to the Image File Wrapper page, the so-called "Miscellaneous Incoming Letter" is a document entitled "Statement Concerning Small Entity Status," which Applicants filed on January 3, 2006, along with the Issue Fee Transmittal and the Issue Fee payment. Applicants note, that according to the Patent Term Adjustment History page, that document was erroneously entered twice in the USPTO's Patent Term Adjustment History page; once as "Statement Filed Indicating a Loss of Entitlement to Small Entity Status";¹ and once as "Miscellaneous Incoming Letter." The second, erroneous entry of Applicants' Statement Concerning Small Entity Status apparently resulted in the improper 71-day reduction in patent term adjustment.

Further, Applicants respectfully note that notifying the USPTO of a change in status from small entity to large entity is not a "failure to engage in reasonable efforts" to

¹ Applicants respectfully note that this is an erroneous characterization of the "Statement Concerning Small Entity Status" ("Statement") filed by Applicants on January 3, 2006. Applicants have not indicated in the Statement any "Loss of Entitlement to Small Entity Status," as implied by the USPTO's characterization of Applicant's Statement. Rather, Applicants have merely chosen to no longer claim small entity status, even though they reasonably believe they continue to be entitled to claim small entity status, as clearly outlined in the Statement.

conclude processing or examination of an application” under 37 C.F.R. § 1.704(c)(10) that should result in any reduction of patent term adjustment. In fact, such situations have been specifically addressed in a notice published in the Official Gazette of the U.S. Patent and Trademark Office on June 26, 2001 (copy attached), which recites

The Office is publishing this notice . . . to clarify that submission of certain papers after a “Notice of Allowance,” which do not cause a substantial interference and delay in the patent issue process, are not considered a “failure to engage in reasonable efforts” to conclude processing or examination of an application The following are examples of such papers: . . . (5) Change of Status (small/not small entity) Therefore, the submission of these papers after a Notice of Allowance will not be considered a “failure to engage in reasonable efforts” to conclude processing or examination of an application and would not result in reduction of a patent term adjustment pursuant to 37 CFR 1.704 (c)(10).

Clarification of 37 CFR 1.704(c)(10) - Reduction of Patent Term Adjustment for Certain Types of Papers Filed After Notice of Allowance has been Mailed, 1247 Off. Gaz. Pat. Office 4, 9 (June 26, 2001).

For at least these reasons, Applicants’ filing of a Statement Concerning Small Entity Status along with the Issue Fee Transmittal and Issue Fee payment should not result in any reduction in patent term adjustment. Consequently, it was improper for the USPTO to reduce Applicants’ patent term adjustment from 488 days to 417 days based on either the USPTO’s erroneous entry of Applicants’ Statement Concerning Small Entity Status as a “Miscellaneous Incoming Letter” or on the filing of a Statement indicating that Applicants are choosing to no longer claim small entity status.

II. Conclusion

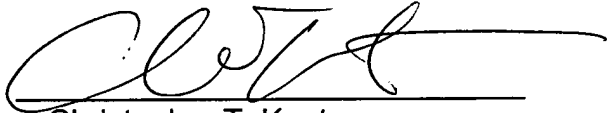
In view of the foregoing, Applicants respectfully request that the current 417-day patent term adjustment of U.S. Patent No. 7,011,498 be reconsidered and that a 488-day patent term adjustment be applied instead. Applicants further request application of the correct patent term adjustment, regardless of Applicants' calculation. Further, if Applicants' calculation is applied, but is later found to be in error, Applicants respectfully request that no prejudice result from any such unintentional error.

Please grant any extensions of time required to enter this Application for Patent Term Adjustment and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: March 31, 2006

By: 
Christopher T. Kent
Reg. No. 48,216

Attachments: Copy of Determination
Copy of Patent Term Adjustment History
Copy of "Miscellaneous Incoming Letter" entered January 3, 2006
Copy of Notice in Official Gazette of the USPTO



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,304	01/22/2002	David W. Vos	13232.00023	5251

22852 7590 10/04/2005

FINNEGAN, HENDERSON, FARABOW, GARRETT &
DUNNER

LLP

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WASHINGTON, DC 20001-4413

EXAMINER

RODRIGUEZ, WILLIAM H

ART UNIT

PAPER NUMBER

3746

DATE MAILED: 10/04/2005

Determination of Patent Term Adjustment under 35 U.S.C. 154 (b)
(application filed on or after May 29, 2000)

The Patent Term Adjustment to date is 488 day(s). If the issue fee is paid on the date that is three months after the mailing date of this notice and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice, the Patent Term Adjustment will be 488 day(s).

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571) 272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at (703) 305-8283.



Printer Friendly

10/051,304

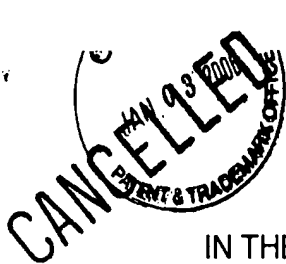
OPTIMIZATION METHOD FOR POWER GENERATION SYSTEMS

Patent Term Adjustment History

Patent Term Adjustment (PTA) for Application Number: 10/051,304			
			Days
Filing or 371(c) Date:	01-22-2002	USPTO Delay (PTO):	579
Issue Date of Patent:	03-14-2006	Three Years:	-
Pre-Issue Petitions (days):	+0	Applicant Delay(APPL):	162
Post-Issue Petitions (days):	+0	Total PTA:	417
USPTO Adjustment(days):	+0	Explanation Of Calculations	
Patent Term Adjustment History			
Date	Contents Description	PTO(Days)	APPL (Days)
03-14-2006	Patent Issue Date Used in PTA Calculation		
02-22-2006	PTA 36 Months		
01-24-2006	Dispatch to FDC		
01-13-2006	Application Is Considered Ready for Issue		
01-03-2006	Miscellaneous Incoming Letter	↑	71
01-03-2006	Statement Filed Indicating a Loss of Entitlement to Small Entity Status	↑	↑
01-03-2006	Issue Fee Payment Verified	↑	↑
01-03-2006	Issue Fee Payment Received	↑	↑
10-04-2005	Mail Notice of Allowance	↑	↑
10-03-2005	Notice of Allowance Data Verification Completed	↑	↑
08-15-2005	Correspondence Address Change	↑	↑
08-15-2005	Change in Power of Attorney (May Include Associate POA)	↑	↑
08-15-2005	Date Forwarded to Examiner	↑	↑
08-02-2005	Response after Non-Final Action	↑	91
08-02-2005	Request for Extension of Time - Granted	↑	↑
03-17-2005	Mail Examiner Interview Summary (PTOL - 413)	↑	↑
02-11-2005	Examiner Interview Summary Record (PTOL - 413)	↑	↑
02-03-2005	Mail Non-Final Rejection	↑	↑
02-02-2005	Non-Final Rejection	↑	
01-27-2005	Incoming Letter Pertaining to the Drawings	↑	↑
01-04-2005	Case Docketed to Examiner in GAU	↑	
12-02-2004	Date Forwarded to Examiner	↑	
11-22-2004	Response to Election / Restriction Filed	↑	
11-22-2004	Workflow incoming amendment IFW	↑	
10-21-2004	Mail Restriction Requirement	579	
10-20-2004	Requirement for Restriction / Election	↑	
05-25-2004	Correspondence Address Change	↑	

05-25-2004	Change in Power of Attorney (May Include Associate POA)	↑	
04-16-2004	Transfer Inquiry to GAU	↑	
04-07-2004	IFW TSS Processing by Tech Center Complete	↑	
05-21-2003	Oath or Declaration Filed (Including Supplemental)	↑	
05-21-2003	New or Additional Drawing Filed	↑	
08-25-2002	Receipt of all Acknowledgement Letters	↑	
08-20-2002	Case Docketed to Examiner in GAU	↑	
06-28-2002	Application Dispatched from OIPE	↑	
06-11-2002	Application Is Now Complete	↑	
05-21-2002	Payment of additional filing fee/Preexam	↑	
05-21-2002	A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applic	↑	
05-21-2002	Applicant has submitted new drawings to correct Corrected Papers problems	↑	
02-21-2002	Notice Mailed--Application Incomplete--Filing Date Assigned	↑	
02-15-2002	Referred by L&R for Third-Level Security Review. Agency Referral Letter Generated	↑	
02-08-2002	IFW Scan & PACR Auto Security Review	↑	
01-30-2002	IFW Scan & PACR Auto Security Review	↑	
01-22-2002	Initial Exam Team nn	↑	

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PATENT
Customer No. 22,852
Attorney Docket No. 09454.0002-02000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
David W. VOS et al.) Group Art Unit: 3745
)
Application No.: 10/051,304) Examiner: William Rodriguez
)
Filed: January 22, 2002) Confirmation No.: 5251
)
For: OPTIMIZATION METHOD FOR)
POWER GENERATION SYSTEMS)
)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

STATEMENT CONCERNING SMALL ENTITY STATUS

In an overabundance of caution, Applicants submit this Statement Concerning Small Entity Status ("Statement") in a good faith effort to fully comply with their obligations under 37 C.F.R. § 1.27(g)(2) to notify the U.S. Patent and Trademark Office (USPTO). Until such time as Applicants provide the USPTO with notice to the contrary, Applicants will discontinue asserting their right to claim small entity status and pay small entity fees.

This Statement is not intended to be construed as an indication that Applicants are necessarily no longer eligible to claim small entity status, that there has necessarily been any change in Applicants' status that would result in Applicants no longer being able to claim small entity status, or that Applicants have necessarily lost their right to claim small entity status. In fact, Applicants believe that they have been eligible to claim small entity status and that they continue to be eligible to claim small entity status. By

this Statement and by Applicants payment of large entity fees, Applicants have merely chosen to no longer assert their right to claim small entity status and pay small entity fees.

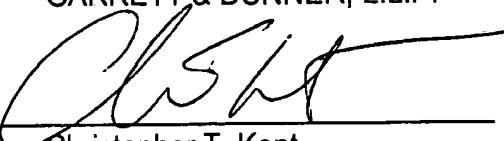
Please grant any extensions of time required to enter this Statement and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: January 3, 2006

By:



Christopher T. Kent
Reg. No. 48,216



Clarification of 37 CFR 1.704(c)(10) -
 Reduction of Patent Term Adjustment for
 Certain Types of Papers Filed
 After a Notice of Allowance has been Mailed

Patent term adjustment under 35 U.S.C. 154(b)(1) is reduced by the period of time during which the applicant "failed to engage in reasonable efforts" to conclude prosecution (i.e., processing or examination of an application). See 35 U.S.C. 154(b)(2)(C)(i). Pursuant to 35 U.S.C. 154(b)(2)(C)(iii), the United States Patent and Trademark Office (Office) has prescribed regulations setting forth the circumstances constituting a failure to engage in reasonable efforts to conclude prosecution (i.e., processing or examination of an application). See 37 CFR 1.704. After a "Notice of Allowance" has been mailed, submissions by an applicant that cause a delay in processing or examination of an application will be considered a "failure to engage in reasonable efforts" to conclude prosecution. See 37 CFR 1.704(c)(10) ("failure to engage in reasonable efforts" to conclude prosecution includes submission of an amendment under 37 CFR 1.312 or other paper after a "Notice of Allowance" has been mailed). The reason such a submission is considered a "failure to engage in reasonable efforts" to conclude processing or examination of an application is that delaying the submission of such papers until after an application is allowed causes substantial interference and delay in the patent issue process. See Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term, 65 Fed. Reg. 56365, 56373 (Sept. 18, 2000); 1239 Off. Gaz. Pat. Office 14, 19-20 (Oct. 3, 2000) (final rule).

It should be noted, however, that only certain papers (not all papers), filed after a "Notice of Allowance" is mailed, cause substantial interference and delay in the patent issue process. Therefore, it is the filing of these papers that will be considered a "failure to engage in reasonable efforts" to conclude processing and examination of an application under 37 CFR 1.704. The Office has reviewed many allowed applications (mostly continued prosecution applications (CPAs)) that were filed on or after May 29, 2000, in which the issue fee was paid. The review consistently showed that only certain papers submitted after a "Notice of Allowance" is mailed, interfered with and delayed the patent issue process to such a degree as to constitute a "failure to engage in reasonable efforts" to conclude processing or examination of an application.

Accordingly, the Office is publishing this notice to provide guidance in interpreting the provisions of 37 CFR 1.704(c)(10) to clarify that submission of certain papers after a "Notice of Allowance," which do not cause substantial interference and delay in the patent issue process, are not considered a "failure to engage in reasonable efforts" to conclude processing or examination of an application. The following are examples of such papers: (1) Issue Fee Transmittal (PTOL-85B), (2) Power of Attorney, (3) Power to Inspect, (4) Change of Address, (5) Change of Status (small/not small entity status), (6) a response to the examiner's reasons for allowance, and (7) letters related to government interests (e.g., those between NASA and the Office). Therefore, the submission of these papers after a Notice of Allowance will not be considered a "failure to engage in reasonable efforts" to conclude processing or examination of an application and would not result in

reduction of a patent term adjustment pursuant to 37 CFR 1.704(c)(10).

In contrast, the submission of other papers after a "Notice of Allowance" is mailed that do cause substantial interference and delay in the patent issue process are considered a "failure to engage in reasonable efforts" to conclude processing or examination of an application pursuant to 37 CFR 1.704(c)(10). The following are examples of such papers: (1) a request for a refund, (2) a status letter, (3) amendments under 37 CFR 1.312, (4) late priority claims, (5) a certified copy of a priority document, (6) drawings, (7) letters related to biological deposits, and (8) oaths or declarations.

As guidance for minimizing reductions to any patent term adjustment, applicants should adopt practices that do not delay processing of the applications after the "Notice of Allowance" has been mailed. For instance, instead of filing corrected drawings or editorial amendments after the application has been allowed, applicant should submit such corrected drawings or editorial amendments prior to allowance of the application. In addition, instead of filing a status letter, applicant should use the private Patent Application Information Retrieval (PAIR) system to determine the status of the application (<http://pair-direct.uspto.gov>) or call the Office.

The Patent Application Locating and Monitoring (PALM) system maintains computerized contents records of all patent applications and reexaminations. PAIR is a system that provides public access to PALM for patents and applications that have been published (i.e., information for applications maintained in confidence cannot be obtained), which can be accessed over the Internet at <http://pair.uspto.gov>. The private side of PAIR at <http://pair-direct.uspto.gov> can be used by an applicant to access confidential information about his or her pending application. To access the private side of PAIR, a customer number must be associated with the correspondence address for the application, and the user of the system must have a digital certificate. For further information, contact the Customer Support Center of the Electronic Business Center at (703) 305-3028.

In addition, if PAIR is used to see the PALM records that are relied upon for patent term adjustment purposes, a contents entry with the contents code "DRWS" and the contents description "DRAWING REQUIREMENTS SATISFIED" does not indicate when the drawings were filed and is not a PALM entry that is used in the patent term adjustment calculation.

Any questions or comments about this change should be directed to Karin Tyson, Senior Legal Advisor, Office of Patent Legal Administration, Office of the Deputy Commissioner for Patent Examination Policy. Ms. Tyson can be reached by telephone at (703) 306-3159, or by e-mail at Karin.Tyson@uspto.gov.

May 29, 2001

NICHOLAS P. GODICI
Acting Under Secretary of
Commerce for Intellectual Property and
Acting Director of the United States
Patent and Trademark Office